

ESTTA Tracking number: **ESTTA35087**

Filing date: **06/07/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<b>Proceeding</b>	91161373
<b>Party</b>	Plaintiff American Italian Pasta Company ,
<b>Correspondence Address</b>	THOMAS H. VAN HOOZER HOVEY WILLIAMS LLP 2405 GRAND BLVD. SUITE 400 KANSAS, MO 64108
<b>Submission</b>	OPPOSER'S REPLY TO APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION
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<b>Signature</b>	/TVH/
<b>Date</b>	06/07/2005
<b>Attachments</b>	Opposer's Reply Brief re Amend Notice of Opposition.pdf ( 10 pages )

**AMERICAN ITALIAN PASTA  
COMPANY**

) ) ) ) ) ) ) ) ) )

**V.**

**Applicant.**

Responsive to Opposer's Interrogatories and Requests for Production, Applicant initially produced documents on January 28, 2005, and after entry of a protective order, produced additional documents on March 30, 2005. Approximately one month later, Opposer filed a Motion for Leave to Amend Notice of Opposition on May 6, 2005, proposing to add a claim stating that, at the time

of filing its application, Applicant did not have a bona fide intention to use the mark in commerce. On May 26, 2005, Applicant filed a Brief in Opposition to Opposer's Motion. Discovery is set to close in this case on June 7, 2005.

## **ARGUMENTS**

### **1. Opposer's Motion was Timely Filed, and Applicant will Not be Prejudiced by Allowance of the New Claim.**

On September 24, 2004, Opposer served it First Set of Interrogatories and First Set of Requests for Production on Applicant. Opposer's Interrogatory No. 30 specifically asked for all facts supportive of Applicant's bona fide intention to use the mark in commerce. Opposer's Request No. 2 was for all documents and things referring or relating to the creation, selection or adoption of Applicant's Mark; Opposer's Request No. 16 was for all documents and things concerning or supporting Applicant's statement that, at the time of filing of the application, Applicant had a bona fide intention to use the mark in commerce. When, on January 28, 2005, Applicant filed its initial responses to Opposer's discovery requests, Applicant objected to Interrogatory No. 30, stating that it called for information protected from disclosure by the attorney-client privilege and/or the attorney work-product doctrine.<sup>1</sup> Applicant objected to Request Nos. 2 and 16, stating that they called for documents or materials protected by the attorney-client privilege and/or the attorney work-product doctrine. Applicant also stated that any responsive, non-privileged documents would be produced.

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<sup>1</sup>

Applicant's only substantive response to the request for facts supporting its claim in Interrogatory No. 30 was the conclusory assertion of future intent that, "[s]ubject to the foregoing objections, Barilla plans to use BARILLA - AMERICA'S FAVORITE PASTA in packaging, collateral and sales materials."

There were, however, no “non-privileged” or other documents produced responsive to these requests. Upon entry of a protective order, and as noted in footnote 1 of Applicant’s Brief in Opposition, additional documents were produced on March 30, 2005. Again, no documents were produced by Applicant responsive to these specific requests regarding Applicant’s alleged bona fide intention to use the mark in commerce.

Opposer was unable, due to the very nature of this proposed claim, to determine whether or not the proposed claim was warranted prior to Applicant’s failure to provide any facts of its good faith bona fide intent, or to produce any responsive documents concerning its alleged bona fide intention to use the mark in commerce at the time when this application was filed. Although the Facts portion of Applicant’s Brief specifically stated at page 2 that Applicant did not move to amend the Notice of Opposition until “fully three months after Applicant served its discovery responses on Opposer...”, Applicant neglected to include in this ‘factual’ time line that it wasn’t until March 30, 2005, that Applicant produced its confidential documents. This fact was included only in footnote 1 on page 3 of Applicant’s Brief, after having once again mischaracterized the timing involved in Opposer’s filing of its motion as a “three month” delay.

Applicant specifically stated, in its January 28, 2005 responses, that it wouldn’t produce any documents or disclose any information regarding its bona fide intention to use in the mark due to the privileged nature of any such documents or information. Applicant was then forced to wait until after entry of a protective order to see whether or not Applicant would produce any such information or documentation. Once again, even after entry of the protective order, Applicant failed to produce any documents supportive of its bona fide intention to use the mark. It was not until after this second failure to produce that Opposer was in the position to be able to make such a claim. Thus, contrary

to Applicant's allegations, Opposer waited only approximately one month after having received Applicant's responses to move to amend the Notice of Opposition. There simply has been no "long and unexplained delay in filing" the motions, and Applicant is well aware of this fact.

Moreover, Applicant was afforded additional time after such production within which it could have supplemented its responses. The present motion was filed before the close of discovery, and Opposer's attorney not only advised Applicant's attorney orally of the filing, but per her request, transmitted the moving papers electronically and consented to a request to extend discovery for an additional thirty days. Applicant's request for an extension of discovery, and Opposer's agreement to extend the discovery period belies any prejudice or claim thereto. This is especially true in view of the fact that, as of June 7, the extended end of discovery, Applicant has not sought any further discovery from Opposer. Thus, in view of its failure to exercise its opportunity during the period granted, it can hardly be said that Applicant has suffered any prejudice, or demonstrated a need for further extensions.

Opposer agrees with Applicant that the holding in *Commodore Electronics Limited v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993) is directly analogous and binding precedent. It does not, however, in any way agree with the majority of Applicant's characterizations of that holding. Like Opposer in the present case, the opposer in *Commodore* sought leave to amend the pleadings to include a claim that the applicant lacked a bona fide intention to use the mark in commerce. This motion was filed on November 2, 1992, only after the Board issued a decision on a summary judgment motion, dated October 1, 1992, which would have disposed of the case. The Board found that opposer was justified in delaying the filing of the motion pending the Board's ruling, stating that the opposer "promptly sought leave to amend, filing the motion therefor within,

approximately, one month of the Board's denial of summary judgment." *Id.*, page 1506. (Emphasis added.) The Board has thus stated its belief that a brief one-month time period in filing a motion would not prejudice the applicant.

Leave to amend should be freely given when justice so requires, according to Fed. R. Civ. P. 15(a). Further, Opposer's proposed amendment is warranted as, through discovery, Opposer has learned that Applicant did not have a single document which would establish its bona fide intention to use the mark in commerce. Clearly, all of the documents which would support Applicant's claim of bona fide intention to use the mark are within the control of Applicant, and if any such documents actually exist, they should already have been produced in response to Opposer's Request for Production or Interrogatories. It is difficult to imagine how Applicant could now be prejudiced by its own failure to produce responsive documents under its control.

Finally, discovery in the present case is currently set to close on June 7, 2005. Not only has Applicant had sufficient time within which to supplement its discovery responses, if any such responsive documents were actually to exist, but Applicant has also had sufficient time within which to serve additional discovery requests if it had so desired. In fact, this approximately one-month time period is the same one-month period which Applicant contends was more than ample time, and in fact constituted an unduly long delay, for Opposer to have filed this Motion subsequent to Applicant's last production of documents. The absence of any activity during the consented extension demonstrates that Applicant has failed to show any need for further extensions, and Opposer leaves it to the Board to assess whether Applicant's request in this regard is supported.

Accordingly, Opposer's motion is certainly not untimely, and by no means will Applicant be prejudiced by allowance of this new claim.

**2. Applicant's Proposed Claim Does State a Claim Upon Which Relief Can Be Granted.**

Opposer's does not, as Applicant claims in its brief, allege that "Applicant fraudulently signed a declaration attesting to its bona fide intention to use the opposed mark in commerce." Opposer proposes to add a claim that Applicant lacked a bona fide intention to use the mark in commerce at the time the application was filed, as is essential to a trademark filing made under Section 1(b). Lack of bona fide intention to use the mark can be found where, as in the present case, there is an "absence of any documents evidencing applicant's claimed intention to use its mark". *Id.*, at 1506.

In fact, the Board in *Commodore* specifically held:

...absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b). An allegation to such effect, therefore, **states a claim upon which relief can be granted.**" (Emphasis added.)

*Id.*, at 1507.

In *Commodore*, the opposer sought to add a claim to the Notice of Opposition as follows:

7. Upon information and belief Applicant did not have a bona fide intention to use the mark in commerce on the specified services when it filed this and its other applications to register...

*Id.* at 1504.

Contrary to Applicant's account of the *Commodore* case, on page 4 of its Brief, the opposer therein never identified the specific discovery requests supporting its claim. In fact, the Board even acknowledged that the opposer never included a copy of opposer's discovery requests or applicant's responses thereto in either opposer's motion or its response to the applicant's motion. See, *Commodore*, page 1507, f.n. 12. The Board, while recognizing that opposer's amendment did not

set forth any further facts to provide applicant with notice of why opposer believed that applicant lacked the bona fide intent, nevertheless found it to be “apparent from opposer’s argument that the factual basis underpinning its assertion of a lack on the part of applicant of a bona fide intent to use is the absence of any documentary evidence to support applicant’s professed intent.” *Id.*, at 1506. The Board went on to accept the proposed claim after, *sua sponte*, amending it to read as follows:

7. Upon information and belief Applicant did not have a bona fide intent to use the mark in commerce on the specified goods when it filed this and its other applications... because Applicant does not have a single document to establish a bona fide intention to use [the mark] in commerce on any of the many goods covered in its various applications to register...

*Id.*, at 1508.

Opposer stated in its Motion for Leave to Amend that the additional grounds were based on information revealed as a result of the discovery responses from Applicant. Applicant states in its brief that it reviewed its responses and found nothing supportive of Opposer’s claim. In footnote 1, Applicant even admitted that “[n]othing in those documents possibly relates to a lack of a bona *[sic]* intention to use”. Thus, particularly after reviewing the *Commodore* case relied upon so heavily by Applicant, Applicant should not have been “startled” by this claim, and further it should have been aware that its total lack of documentation supportive of its professed intent could have been the basis for Opposer’s allegations. As in the *Commodore* case, the proposed claim clearly states a claim upon which relief can be granted.

In addition, on the same date that Applicant filed the opposed intent-to-use application, it appears that it also filed three other applications for similar marks for the identical goods.<sup>2</sup> These

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<sup>2</sup>BARILLA - AMERICA'S #1 PASTA, Ser. No. 78/136,706; BARILLA - AMERICA'S PREFERRED PASTA, Ser. No. 78/136,708; and BARILLA - AMERICA'S BEST PASTA, Ser. No. 78/136,701. These applications, and the opposed application, were all filed on June 18, 2002



simultaneously-filed applications are the subject of Opposer's outstanding discovery requests.<sup>3</sup> This multiple filing of intent-to-use applications for nearly identical marks further compounds Applicant's demonstrated lack of bona fide intent. The legislative history of the Trademark Law Revision Act of 1988 discussed the meaning of "bona fide" and "good faith" as used in the intent to use provision of Section 1(b). The Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988), included an illustrative list of circumstances which "may cast a doubt on the bona fide nature of the intent or even disprove it entirely". These include: filing numerous intent-to-use applications for a variety of marks to be used on one new product; and filing numerous intent-to-use applications for marks consisting of or including descriptive (at least initially) terms describing some important characteristic of a new product (here, all of these initially descriptive phrases are combined with Applicant's house mark BARILLA). The circumstances listed in the Senate Report are clearly intended to prevent situations such as Applicant's simultaneous filing of multiple, nearly identical intent-to-use applications, by casting doubt on or disproving the bona fide nature of Applicant's intent. Again, Applicant's multiple filings, coupled with the lack of documents as revealed during the discovery process, further supports Opposer's proposed claim.

## CONCLUSION

As set forth by the facts in the present case, Opposer's motion was timely filed, and Applicant will not be prejudiced by acceptance of the new claim. Further, the proposed claim does

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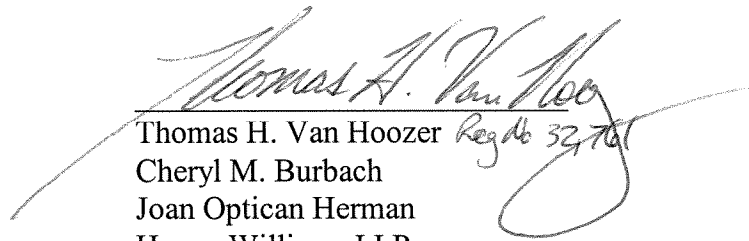
for "pasta, pasta products, sauces for pasta."

<sup>3</sup> Opposer's First Request for Admissions to Applicant, filed May 6, 2005, were directed to these co-pending applications.

state a claim upon which relief can be granted. Accordingly, Opposer respectfully requested its Motion for Leave to Amend be granted.

Dated: June 7, 2005

Respectfully submitted,

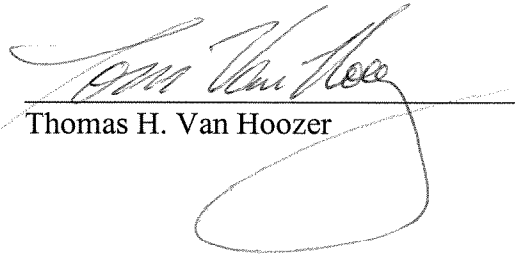
A handwritten signature in cursive script, reading "Thomas H. Van Hoozer". The signature is written in dark ink and is positioned above the printed name and address. There is a small, handwritten note "Reg No 32,761" written in the right margin next to the signature.

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**CERTIFICATE OF SERVICE**

I hereby certify that on the 7th day of June, 2005, I served the foregoing OPPOSER'S REPLY TO APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION by causing a true copy thereof to be sent via first class, postage paid, to the following:

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